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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/799,826
Filing Date: March 12, 2004
Appellant(s): FORGET SHIELD, DANIELLE RENEE

D. Brit Nelson
Reg. No. 40,370
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7 May 2009 appealing from the Office action mailed 23 December 2008.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

Kasik	(US 6,448,898 B1)	09-2001
Hershey et al.	(US 6,108,524)	02-1998
Hassett	(US 5,347,274)	09-1992

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. **Claims 1, 3-15, 17-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kasik (US 6,448,898 B1)** in view of **Hershey et al. (US 6/108,524)** (hereinafter "**Hershey**").

3. **With respect to claim 1: (Currently Amended)** Kasik discloses:

- a. billing a customer associated with a waste removal, and paying personnel for services associated with the waste removal; (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system) and
- b. an electronic portable unit having a memory, processor, an input element, and an output element, the portable unit adapted to allow an operator during the waste removal to use the portable unit and to allow onsite input at a customer facility from preprogrammed queries regarding the waste removal and further being adapted to generate an output of the data to the base system for

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processing. (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system).

Kasik does not teach, however Hershey teaches:

c. a waste management electronic base system having a memory, processor, an input element, and an output element, the base system adapted to process waste management data for tracking a waste storage unit at a variety of locations, (Hershey: Figs. 1-2;—col. 1, lines 12-22; col. 3, lines 20-47; col. 4, lines 33-58; col. 5, lines 10-61 - "mobile tracking unit 10 includes a suitable transceiver 52 functionally independent from the navigation set...Transceiver 52 is capable of transmitting the vehicle position data by way of communication link 14 (Fig. 1) to the central station...A low power, short distance radio link is employed between multiple location/tracking units to hold down power consumption and increase reliability and functionality of the tracking system."; Background - column 1, lines 10-67, describe the use of GPS to track assets, including goods and vehicles, the containers, container trucks, and rail cars.)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kasik and Hershey. Kasik teaches a system for auditing refuse collection. This system includes structure for billing subscribers. Hershey

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teaches “while goods are an example of assets that need to be tracked, the containers, container trucks and railcars in which the goods are shipped are themselves assets which need to be tracked, not just because of the goods they carry, but also because they represent capital assets typically of a leasing company not associated with the carrier.” (Hershey col. 1, lines 15-22)

4. **With respect to claims 3 and 17:** Kasik teaches the waste comprises industrial waste and the system is adapted to comply with a manifest associated with the industrial waste. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 50-62 - system contains pre-programmed information about the customer and site; this information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number)

Furthermore, the data identifying type of waste is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir.

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1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004).

Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying type of waste adds little, if anything, to the claimed acts or steps and thus do not serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

5. **With respect to claim 4:** Kasik teaches the base system generates a manifest based on information from a generator of waste obtained from the portable unit. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 50-62 - system contains pre-programmed information about the customer and site; this information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number; col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings

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can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system)

6. **With respect to claims 5 and 20:** Kasik teaches the onsite input allows operator input, automatic input, or a combination thereof. (col. 7, line 35-col. 8, line 47 – process of inputting data from waste container is done automatically).

7. **With respect to claims 6 and 21:** Kasik teaches the onsite input comprises a scanner, keyboard, touch screen, wireless interface, voice recognition interpreter, preprogrammed cards, or a combination thereof. (col. 9, line 50-col. 10, line 36 - service vehicle has wireless system).

8. **With respect to claim 7:** Kasik teaches the portable unit output comprises a wireless interface with the base system. (col. 9, line 50-col. 10, line 36 – wireless LAN system).

9. **With respect to claim 8:** Kasik teaches the system further comprises multiple portable units for multiple operators during their respective routes for multiple waste removals. (col. 10, lines 55-60 – system allows more than one data access points).

10. **With respect to claims 9 and 13:** Kasik teaches the base system is adapted to provide download information to the portable unit, the information containing instructions to the operator for a route of the operator. (col. 7, lines 35-67; col. 8, lines 16-65; col. 9, line 30-col. 10, line 36 – service vehicle has wireless system; wireless LAN system; system processes data from the vehicle which is obtained from the container; when the operator is alerted that the system is not able to identify the subscriber, the operator can

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then follow the steps of taking a renewed reading, perform a manual reading or enter the information manually, for example; a laptop can be used as well to input data in situations that necessitate manual entry).

Furthermore, the data identifying type of information is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner must determine whether the claimed nonfunctional descriptive material should be given patentable weight. The Patent and Trademark Office (PTO) must consider all claim limitations when determining patentability of an invention over the prior art. *In re Gulack*, 703 F.2d 1381, 1385, 217 USPQ 401,404 (Fed. Cir. 1983). The PTO may not disregard claim limitations comprised of printed matter. *See Gulack*, 703 F.2d at 1384-85, 217 USPQ at 403; *see also Diamond v. Diehr*, 450 U.S. 175, 191, 209 USPQ 1, 10 (1981). However, the examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. *See In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

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The Examiner asserts that the data identifying type of information adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

11. **With respect to claims 10, 14 and 23:** Kasik teaches the portable unit is adapted to require predetermined operator input for a first operation to release the operator to perform a next operation. (col. 6, lines 32-43; col. 6, line 44-col. 8, line 65 - after collection flag automatically returns to original position; data regarding collection is inputted into system).

12. **With respect to claims 11 and 19:** Kasik teaches the portable unit is adapted to output an invoice for a customer at the customer site relative to the waste removal. (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system).

13. **With respect to claim 12: (Currently Amended)** Kasik teaches:

- i. billing a customer associated with a waste removal; and

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ii. paying personnel for services associated with the waste removal; (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67 – data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system) and

b. using an electronic portable unit having a memory, processor, an input element, and an output element, to gather onsite data for the base system, comprising:

i. allowing an operator to input onsite data at a customer facility into the portable unit from preprogrammed queries regarding the waste removal; and (col. 9, lines 5-50 - “The operator then take the appropriate corrective measures (e.g., take a renewed reading, perform a manual reading, enter the information manually etc)

ii. generating an output of the data to the base system for processing.

(col. 7, lines 35-67; col. 8, lines 16-65; col. 9, line 50-col. 10, line 36 – service vehicle has wireless system; wireless LAN system; system processes data from the vehicle which is obtained from the container).

Kasik does not teach, however Hershey teaches:

iii. tracking a waste storage unit at a variety of locations;

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(Hershey: Figs. 1-2;—col. 1, lines 12-22; col. 3, lines 20-47; col. 4, lines 33-58; col. 5, lines 10-61 - "mobile tracking unit 10 includes a suitable transceiver 52 functionally independent from the navigation set...Transceiver 52 is capable of transmitting the vehicle position data by way of communication link 14 (Fig. 1) to the central station...A low power, short distance radio link is employed between multiple location/tracking units to hold down power consumption and increase reliability and functionality of the tracking system.")

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Kasik and Hershey. Kasik teaches a system for auditing refuse collection. This system includes structure for billing subscribers. Hershey teaches "while goods are an example of assets that need to be tracked, the containers, container trucks and railcars in which the goods are shipped are themselves assets which need to be tracked, not just because of the goods they carry, but also because they represent capital assets typically of a leasing company not associated with the carrier." (Hershey col. 1, lines 15-22)

14. **With respect to claim 15:** Kasik teaches scanning input information into the portable unit regarding a waste storage unit. (col. 7, lines 5-23 – containers can have barcode markings/labels that can be accessed and read).

15. **With respect to claim 18:** Kasik teaches accepting an electronic manifest into the portable unit. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 50-62 - system contains pre-programmed information about the customer and site; this

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information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number).

16. **With respect to claim 22:** Kasik teaches sharing information between the portable unit and the base system through a wireless interface. (col. 7, lines 35-67; col. 8, lines 16-65; col. 9, line 50-col. 10, line 36 – service vehicle has wireless system; wireless LAN system; system processes data from the vehicle which is obtained from the container).

17. **Claims 2 and 16** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Kasik** in view of **Hershey** and further in view of **Hassett (US 5,347,274)**.

18. **With respect to claims 2 and 16: (Currently Amended)** Kasik/Hershey teaches the limitations in the rejections above. However, Kasik/Hershey does not teach a waste removal vehicle, wherein the waste storage unit is selectively coupled with the waste removal vehicle. Hassett teaches a waste removal vehicle, wherein the waste storage unit is selectively coupled with the waste removal vehicle. (col. 3, lines 52-62 – “the invention contemplates embodiments adapted to all modes of transport...the term “vehicle” as used in the disclosure and the patent claims herein is to include boat, airplane, truck, rail car or engine, and all other forms of transport vehicle, as well as such tanks, containers or vessels as may demountably attach to or be carried by a transport vehicle”).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to combine to portable wireless waste removal system of Kasik

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with the waste removal and storage unit in Hassett because of the need to not only have a system where waste can be kept if disposal is not readily available. It is also necessary to have a system that tracks information related to the waste such as location. Kasik teaches a system for auditing refuse collection. This system includes structure for billing subscribers. Hershey teaches "while goods are an example of assets that need to be tracked, the containers, container trucks and railcars in which the goods are shipped are themselves assets which need to be tracked, not just because of the goods they carry, but also because they represent capital assets typically of a leasing company not associated with the carrier." (Hershey col. 1, lines 15-22)

(10) Response to Argument***Response to Arguments*****A.) The Rejections of claims 1, 3-15 and 17-23 under 35 USC 103(a) as being unpatentable over Kasik (US 6,448,898 B1) in view of Hershey et al. (US 6,108,524) was proper was proper.**

- 1.) Hindsight was not the rationale used to combine the Kasik and Hershey references.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in

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the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

Furthermore, MPEP 2141 states:

In *KSR*, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at ___, 82 USPQ2d at 1395. The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at ___, 82 USPQ2d at 1395. (1) “In *United States v. Adams*, [t]he **Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.**” *Id.* at ___, 82 USPQ2d at 1395. (2) “In *Anderson 's-Black Rock, Inc. v. Pavement Salvage Co.*, ...[t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation.” *Id.* at ___, 82 USPQ2d at 1395. (3) “[I]n *Sakraida v. AG Pro, Inc.*, the Court derived . . . the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at ___, 82 USPQ2d at 1395-96 (Internal quotations omitted.).

In the current application, the combination of Kasik and Hershey was not presented based on hindsight. It is old and well known in the art of the invention to have a system that tracks waste. In the Background of Appellant's specification Appellant notes on page 1 that a manifest was used for waste transported to the landfill as a reporting requirement for governmental agencies. As such, the manifest in many ways served as a chain of custody form. A form filled out using paper is obviously converted to electronic application. In the Hershey reference in column 1, lines 10-67,

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describe the use of GPS to track assets, including goods and vehicles, the containers, container trucks, and rail cars. Essentially, the Kasik reference teaches that trash is collected in a container truck or service vehicle (see Fig. 5B) that tracks the pickup location of the trash container and the Hershey reference teaches that container trucks can be tracked at multiple locations.

2.) The application of Kasik and Hershey in the above rejection fulfills the KSR requirements.

Claims 1, 3-15 and 17-23 are properly taught by Kasik in view of Hershey and rejected under 35 U.S.C. §103(a).

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at ___, 82 USPQ2d at 1395. The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at ___, 82 USPQ2d at 1395. (1) “In *United States v. Adams*, [t]he **Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.**” *Id.* at ___, 82 USPQ2d at 1395. (MPEP 2141)

Accordingly, references used in a 35 USC 103 rejection must be analyzed in combination with each other and not separately. Applicant argues that the Kasik reference neglects to teach the limitation of tracking the waste from point to point. Kasik,

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as Appellant admits teaches a refuse collection service. The Hershey reference teaches that once the container or truck leaves the collection site it is tracked throughout a plurality of locations. Appellant needs to review both references together and not separately.

Applicant incorrectly argues on page 15 of the appeal brief that the item noted in the rejections as pertaining to tracking was a CCD camera cited in Kasik. On the contrary, the following citation from the Hershey reference was used to teach the limitation "the tracking a waste storage unit at a variety of locations"; (Hershey: Figs. 1-2;-col. 1, lines 12-22; col. 3, lines 20-47; col. 4, lines 33-58; col. 5, lines 10-61 - "mobile tracking unit 10 includes a suitable transceiver 52 functionally independent from the navigation set...Transceiver 52 is capable of transmitting the vehicle position data by way of communication link 14 (Fig. 1) to the central station...A low power, short distance radio link is employed between multiple location/tracking units to hold down power consumption and increase reliability and functionality of the tracking system.")

3.) The combination of Kasik and Hershey does not present the issue of undue experimentation.

The combination of Kasik and Hershey is obvious and would not necessitate undue experimentation. One of skill in the art of waste management is aware that waste collected from a customer's location is not just placed in a truck or container and kept in the customer's drive way, parking lot or the collection location. A truck is used to collect

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the waste because the disposal sight is elsewhere. So the tracking of the truck, the container, or both at a plurality of locations in the Hershey reference would have been an obvious to one of skill in the art.

Applicant incorrectly argues prohibitive hindsight.

Furthermore, MPEP 2141 states:

In KSR, the Supreme Court particularly emphasized “the need for caution in granting a patent based on the combination of elements found in the prior art,” *Id.* at ___, 82 USPQ2d at 1395, and discussed circumstances in which a patent might be determined to be obvious. Importantly, the Supreme Court reaffirmed principles based on its precedent that “[t]he combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *Id.* at ___, 82 USPQ2d at 1395. The Supreme Court stated that there are “[t]hree cases decided after *Graham* [that] illustrate this doctrine.” *Id.* at ___, 82 USPQ2d at 1395. (1) “In *United States v. Adams*, [t]he **Court recognized that when a patent claims a structure already known in the prior art that is altered by the mere substitution of one element for another known in the field, the combination must do more than yield a predictable result.**” *Id.* at ___, 82 USPQ2d at 1395. (2) “In *Anderson’s-Black Rock, Inc. v. Pavement Salvage Co.*, ...[t]he two [pre-existing elements] in combination did no more than they would in separate, sequential operation.” *Id.* at ___, 82 USPQ2d at 1395. (3) “[I]n *Sakraida v. AG Pro, Inc.*, the Court derived . . . the conclusion that when a patent simply arranges old elements with each performing the same function it had been known to perform and yields no more than one would expect from such an arrangement, the combination is obvious.” *Id.* at ___, 82 USPQ2d at 1395-96 (Internal quotations omitted.).

In the current application, the combination of Kasik and Hershey was not presented based on hindsight. It is old and well known in the art of the invention to have a system that tracks waste. In the Background of Appellant's specification Appellant notes on page 1 that a manifest was used for waste transported to the landfill as a reporting requirement for governmental agencies. As such, the manifest in many

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ways served as a chain of custody form. A form filled out using paper is obviously converted to electronic application. In the Hershey reference in column 1, lines 10-67, describe the use of GPS to track assets, including goods and vehicles, the containers, container trucks, and rail cars. Essentially, the Kasik reference teaches that trash is collected in a container truck or service vehicle (see Fig. 5B) that tracks the pickup location of the trash container and the Hershey reference teaches that container trucks can be tracked at multiple locations.

The combination of Hershey and Kasik would not enable one skilled in the art to go through undue experimentation. It is an obvious combination.

4.) The combination of Kasik and Hershey makes the claimed invention obvious.

In regards to claims 3-5, 9-13, and 17-19, the Hershey or Kasik references do not have to label data collection "manifest" to teach the purpose of a manifest. According to Dictionary.com, a manifest is a list or invoice of goods transported by truck or train. (<http://dictionary.reference.com/browse/manifest>) This information contains customer, amount, address, contact and other identifying information. The Kasik reference teaches system contains pre-programmed information about the customer and site; this information is part of the auditing system used in the refuse collection process containing subscriber information such as name, address or customer number. (col. 5, lines 5-18; col. 6, lines 44-67; col. 8, lines 30-47; col. 9, lines 10-62) Kasik also teaches an invoice is outputted for a customer at the customer site relative to the waste removal

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and data obtained and transmitted from service vehicle at collection site; containers are marked and can contain barcodes; markings can be read to provide customer address; container flag position and collection frequency factor into labor costs; data collected used to bill customers; data collected is processed by the waste collection system (col. 5, lines 5-19; col. 7, lines 5-64; col. 9, lines 14-63; col. 10, lines 3-12, 27-67). The computing system is used to read data on the container. "The operator then take the appropriate corrective measures (e.g., take a renewed reading, perform a manual reading, enter the information manually etc) (col. 9, lines 5-50). The ability of the operator to enter the information manual shows that the information has to be inputted into the system and therefore the claims are properly rejected.

In regards to claims 14, 20 and 23, the Hershey and Kasik references correctly teach the limitations noted. The limitation of is not positively recited. ..."allowing an operator to input" makes available the equipment for this to happen but does not claim that the operator is actually inputting information. Kasik teaches the process of inputting data from waste container is done automatically. (col. 7, line 35-col. 8, line 47) Furthermore, Kasik teaches after collection flag automatically returns to original position; data regarding collection is inputted into system (col. 6, lines 32-43; col. 6, line 44-col. 8, line 65) "The operator then take the appropriate corrective measures (e.g., take a renewed reading, perform a manual reading, enter the information manually etc) (col. 9, lines 5-50)

In regards to claim 17, Applicant argues that only industrial waste is noted in the references and therefore the claims are not obvious. Examiner argues that the type of waste listed on the manifest is non-functional descriptive data.

When presented with a claim comprising descriptive material, an Examiner need not give patentable weight to descriptive material absent a new and unobvious functional relationship between the descriptive material and the subset. See *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994); *In re Ngai*, 367 F.3d 1336, 1338, 70 USPQ2d 1862, 1863-64 (Fed. Cir. 2004). Thus, when the prior art describes all the claimed structural and functional relationships between the descriptive material and the subset, but the prior art describes a different descriptive material than the claim, then the descriptive material is nonfunctional and will not be given any patentable weight. That is, such a scenario presents no new and unobvious functional relationship between the descriptive material and the subset.

The Examiner asserts that the data identifying type of waste on manifest adds little, if anything, to the claimed acts or steps and thus do no serve as limitations on the claims to distinguish over the prior art. MPEP 2106IV b 1(b) indicates that "nonfunctional descriptive material" is material "that cannot exhibit any functional interrelationship with the way the steps are performed". Any differences related merely to the meaning and information conveyed through data, which does not explicitly alter or impact the steps is non-functional descriptive data. The subjective interpretation of the data does not patentably distinguish the claimed invention.

B.) The Rejections of claims 2 and 16 under 35 USC 103(a) as being unpatentable over Kasik (US 6,448,898 B1) in view of Hershey et al. (US 6,108,524) and further in view of Hassett (US 5,347,274 was proper.

Appellants state that Hassett does not provide the deficiency of the Kasik and the Hershey references without stating what this deficiency is. Hassett teaches a waste transport management system. In column 2, Hassett teaches the tracking of hazardous waste. Hassett teaches a mobile transceiver system with a processor and memory. In column 5, Hassett teaches "Each mobile unit has a unique multi-digit identification number which may be fixed, or may be reassigned and programmed into memory 88 before or during each run of the vehicle. In either case, central data network 2 (Fig. 1) may contain full data record indexed to the identification code that identifies the driver, responsible carrier, nature of the load carried by the vehicle and its destination."

Therefore the rejection including Hassett was proper.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/H. R./
Examiner, Art Unit 3689

Conferees:

/Janice A. Mooneyham/

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